

01-03-2003

U.S. Patent & TMO/c/TM Mail Rpt Dt. #10

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK AND APPEAL BOARD**

TTAB

IN THE MATTER OF TRADEMARK REGISTRATION NO. 2,372,585
Registered August 1, 2000

BOYDS COLLECTION, LTD.,
Petitioner,

v.

HERRINGTON & COMPANY, INC.,
Registrant.

Cancellation No. 32,146

Mark: TBC HERRINGTON'S TEDDY
BEAR CLUB & Design

Registration No.: 2,372,585

Registration Date: August 1, 2000

REGISTRANT'S RESPONSE TO PETITIONER'S MOTION TO SUSPEND

In response to Petitioner BOYDS COLLECTION, LTD. ("Petitioner")'s Motion to Suspend the above captioned action, Registrant HERRINGTON & COMPANY, INC. ("Registrant") hereby responds to the Motion to Suspend. Registrant requests that the Board consider this response under TBMP § 510, 37 C.F.R. § 2.117.

It is well known that the suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board. TBMP § 510. Registrant hereby opposes Petitioner's Motion to Suspend and requests that the Board, in its discretion, deny the Motion to Suspend on the grounds that there was pending at the time Petitioner's Motion to Suspend was filed, a motion that is potentially dispositive of the above cancellation action and that the civil action filed by Petitioner does not involve issues that are directly in common with those in the instant cancellation action. See TBMP § 510.02 (citing to 37 C.F.R. § 2.117(b) and Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, 23129).

On September 10, 2002, Registrant filed a Motion to Strike Petitioner's Notice of Reliance in the above action. On September 27, 2002 Petitioner filed a response to said motion and on October 10, 2002 Registrant filed a reply thereto. This Motion to Strike is currently pending before the Board and was pending when the instant Motion to Suspend was filed by Petitioner. The decision on the Motion to Strike is potentially dispositive of the action as a whole.

It is the policy of the Board to prevent a petitioner who was served with a potentially dispositive motion from escaping that motion by filing a civil action and then moving to suspend before the Board has decided the potentially dispositive motion. See TBMP § 510.02(a). This is exactly what Petitioner is attempting to do in this case.

Therefore, under TBMP § 510.02(a) and 37 C.F.R. § 2.117(b), Registrant respectfully requests that the Board first decide the potentially dispositive motion before the question of suspension is considered.

Additionally, because the civil action recently filed by Petitioner does not deal with the same issues involved in the instant proceeding, we request that the Board exercise its discretion and deny Petitioner's Motion to Suspend.

Dated: December 30, 2002

Respectfully submitted,
HERRINGTON & COMPANY, INC.

By: P. Craig Cardon / ECM
P. Craig Cardon
Elizabeth Moreno McArthur
SQUIRE SANDERS & DEMPSEY L.L.P.
1 Maritime Plaza, Suite 300
San Francisco, CA 94111
Tel: (415) 954-0200
Attorneys for Registrant

Express Mail mailing label No. **EL 952564537 US**

Date of Deposit **January 3, 2003**

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Sadie Lum

(Type or Print Name of Person Mailing Paper or Fee)

Sadie Lum

(Signature of Person Mailing Paper or Fee)

P. Craig Cardon, Esq.
Squire, Sanders & Dempsey L.L.P.
One Maritime Plaza
Suite 300
San Francisco, CA 94111
(415) 954-0200

Attorneys for Registrant

December 30, 2002

BY U.S. EXPRESS MAIL

United States Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513
Attention: Legal Assistant, TTAB

Re: Cancellation No.: 32,146
Mark: TBC HERRINGTON'S TEDDY BEAR CLUB & Design
Registration No.: 2,372,585
Registration Date: August 1, 2000
Registrant: Herrington & Company, Inc.
Our Ref.: 40362.6

Dear Sir or Madam:

Enclosed herewith is Registrant's Response to Petitioner's Motion to Suspend for the above referenced matter. So that we may have a timely record of receipt of the enclosed, please date-stamp the enclosed, stamped, self-addressed post card, and deposit it into the U.S. mail.

Please direct all correspondence regarding this matter to my attention.

Very truly yours,

P. Craig Cardon

P. Craig Cardon
Attorney at Law

PCC/sl

Enclosure

01-03-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #10

03 JAN 10 AM 9:30
U.S. Patent & TMO/TM Mail Rcpt Dt. #10

LP